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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,672	10/07/2003	Robert K. Weir	5055	7699

7590 12/27/2005

John E. Reilly
1554 Emerson Street
Denver, CO 80218

EXAMINER

CINTINS, IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,672

Applicant(s)

WEIR ET AL.

Examiner

Ivars C. Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Applicant's election of Group I, claims 1-22, in the reply filed on October 5, 2005 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 23-27 are withdrawn from further consideration, as being directed to a non-elected invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Applicant has disclosed that "in accordance with the present invention" the apparatus includes a chamber or vault disposed in the path of the run-off having an upper inlet which is in the path of flow of the run-off, a downwardly inclined wedge wire screen extending from the inlet for advancement of the run-off thereacross, a basin including debris-collecting means for collection of solid materials at the lower end of the screen, an organic absorber disposed in the path of run-off passing through the screen for the absorption of organic oils in the run-off, an outlet at a lower end of the chamber, and discharge means for removal of run-off after it has passed through the organic absorber (see the paragraph bridging pages 3 and 4 of the specification). Applicant has further disclosed that the organic oil absorber is in the form of a buoyant pillow or pad which will float on top of the water that accumulates in the basin (see page 4, lines 12-14 of the specification). Claims 1-8 fail to positively recite the wedge wire screen, claims 10-22 fails to positively recite the upper inlet in the chamber, and claims 1-22 fail

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to positively recite the buoyant pillow or pad of organic oil absorber; and therefore, these claims are not enabled by the disclosure. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-22 fail to recite the apparently essential wedge wire screen, the upper inlet in the chamber, and/or the buoyant pillow or pad of organic oil absorber; and therefore, these claims fail to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Also, the term "said wedge wire screen" (claim 9, line 2) no longer has antecedent basis in the claims, and is therefore indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris et al. (U.S. Patent No. 6,106,707). The reference discloses an apparatus comprising: a chamber **100** having an upper inlet **106**, a basin **110** having a screen **120** inclined downwardly through the basin, a buoyant (see col. 7, lines 8-9) organic absorber **130** behind the screen, an outlet at a lower end of the chamber (col. 3, lines 42-44), and discharge means **140** for removal of run-off after it has passed through the organic absorber; and this is all that is required by claims 1-3.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. The reference discloses the claimed invention with the exception of the lower sloped bottom panel. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to slope the bottom of chamber 100, in order to promote flow to the outlet of this chamber.

Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris et al. in view of Nagaoka (U.S. Patent No. 5,476,588). Morris et al. discloses the claimed invention with the exception of the recited wedge wire screen. Nagaoka teaches that wedge wire screens are recognized as being superior to conventional screens because they have little likelihood of clogging (see col. 1, lines 10-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the wedge wire screen of Nagaoka for the screen of the primary reference, in order to obtain the advantages disclosed by this secondary reference (i.e. resistance to clogging) for the system of the primary reference.

Claims 10-22 would be allowed if amended to overcome the above rejections under 35 U.S.C. § 112. Claims 4-7 would also be allowed if amended to overcome the above rejections under 35 U.S.C. § 112, and if further rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

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Applicant's arguments filed June 17, 2005 have been noted and carefully considered, but no longer appear to be relevant in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is 571-272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at 571-272-1166.

The centralized facsimile number for the USPTO is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
December 22, 2005